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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,281

03/09/2005

Juan R. Mateu

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AKERMAN SENTERFITT

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EXAMINER

MATTISON, LORI K

ART UNIT

PAPER NUMBER

1619

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,281	<b>Applicant(s)</b> MATEU ET AL.	
	<b>Examiner</b> LORI MATTISON	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/15/2005</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. All correspondence regarding this application should be directed to Group Art Unit 1619.

#### ***Status of Claims***

Applicant's amendments filed 03/09/2005 to claims 2-10 have been entered. Claims 1-11 remain pending in the current application, of which claims 1-11 are being considered on their merits.

#### ***Claim Objections***

Claim 6 is objected to because of the following informalities:  
trimethylsiloxysilicate is improperly capitalized. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: propylene glycol, butylene glycol, and glycerine are improperly capitalized. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "derivative" in claims 1 and 11 is a term which renders the claims indefinite. The claims do not define what a "glycol derivative" is. Furthermore, the term "ad 100% by weight" is a term which renders the claims indefinite. The claims do not

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define how much is present when the recited reagents are present “ad 100% by weight.”

Because claims 2-10 depend from indefinite claim 1 and do not clarify all of the points of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

Clarification is required.

Regarding claim 5, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation “0.1-5% by weight”, and the claim also recites “1.0-4.5% by weight” which is the narrower statement of the range/limitation.

Regarding claim 11, The phrase “a fatty acid gel-forming agent on the basis of a or fatty acid ester, a glycol derivative, or a mixture thereof” renders the claim indefinite. It is unclear whether a chemical species has been omitted from the claim with the phrase “basis of a or fatty ester...” Clarification is required. Secondly, it is unclear

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whether the phrase "a fatty acid gel-forming agent on the basis ..." means a fatty gel-forming agent selected from..., or a "fatty gel-forming agent derived/based from" or whether the fatty acid gel forming agent is on a base/support that comprises a fatty acid ester, a glycol derivative or mixture. Clarification is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,318,774 (Alban, 1994), US Patent No. 5,565,216 (Coswar, 1996), US Patent No. 5,571,503 (Mausner, 2002), US Patent No. 4,892,727 (Grollier, 1990), US Patent No. 5,207,998 (Robinson, 1993), and US Patent No. 6,074,652 (Ishiwatari, 2000) as evidenced by the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s> and US Patent No. 4,873,078 (Edmundson, 1989).

Example 1 (Col. 11 lines 5-55) of Alban discloses an oil-in-water emulsion, an artificial tanning lotion, which comprises the silicone oil, dimethicone [see evidentiary reference Edmundson (Col. 2, lines 40-45) for the disclosure that dimethicone is a silicone oil]. Hence, the composition comprises an “oil phase.” Example 1 (Col. 11 lines 5-55) of Alban embodies the gel-forming agent and moisturizing substance, butylene glycol, in an amount of 2.0% by weight. Alban teaches that polyhydroxy alcohols (such as butylene glycol) may comprise from 1-30% of the composition (Col. 8, lines 10-30).

Example 1 (Col. 11 lines 5-55) of Alban also embodies the gelling agent glyceryl stearate in an amount of 2.6% by weight. Alban teaches use of the fatty acid esters such as glyceryl behenate (tribehenin) “and the like.” (Col. 5, lines 55-end). Alban teaches use of these fatty acid derivatives in an amount of from “about 0.5 to about 20%” (Col. 6 lines 10-25). Alban teaches that use of fatty acids in an amount from 1-10% is preferable and from 4-6% percent is most preferable (Col. 6 lines 10-25).

Alban teaches use of optional pigments such as gums, resins, thickeners, preservatives, chelators, sequesterants, antioxidants, pigments and opacifiers for use in the composition (Col. 10, lines 50-65). Alban exemplifies use of the filler, fragrance, in an amount of 1.0% by weight in Example 1 (Col. 11 lines 5-55). Alban teaches that these optional components are not limited to the examples he provides for the optional components (Col. 10, lines 50-65). Alban also teaches inclusion of optional ingredients such as sunscreens in a safe or photoprotectively amount such as 0.5-20% by weight of the composition (Col. 7; lines 35-50), humectants in an amount of 1-30% (Col. 8, lines

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10-35), copolymers in an amount of 0.025 -2.0% (Col. 10, lines 1-10), and emollients in an amount of 1-50% (Col. 10, lines 20-25).

The composition of Example 1 of Alban comprises 73.62% by weight water. Thus, the emulsion comprises a water phase. Alban teaches that a portion of the water, 8.0%, is required, but approximately 65% of it is "optional" and be added to adjust the proportions to a 100% (i.e. "water q.s." or "as much as is enough" as defined by the Free online medical dictionary)

Alban exemplifies use of the nonionic emulsifier (i.e. non-ionic surface active agent) Ceteareth-20 [see Coswar (Col. 7 lines 30-45) for the disclosure that Ceteareth-20 is a nonionic emulsifier] in an amount of 0.5% by weight of the Composition of Example 1 (Col. 11 lines 5-55).

The composition further comprises auxiliaries such DMDM hydantoin (i.e. 1,3-bis(hydroxymethyl)-5,5-dimethylimidazolidine-2,4-dione, a preservative).

With regard to the film forming agent, Alban exemplifies use of the film forming agent, trimethylsiloxysilicate and dimethicone (as DC 593 fluid), in an amount of 2.00% the weight of the composition (Col. 11 lines 10-55).

No waxes or hydrocarbon solvents are disclosed by Example 1 of Alban; therefore, it is free of waxes and hydrocarbon solvents.

Alban does not teach the fatty acid esters glyceryl palmitate or glyceryl arachidate, nor does Alban teach use of Alban does not teach use of fatty acid esters in an amount from 0.1 to about 10%.

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Mausner teaches that glyceryl stearate, glyceryl palmitate, and glyceryl arachidate are long chain fatty acid esters which may included in the antipollution cosmetics (Col. 2 lines 50-63), thus Mausner teaches glyceryl palmitate and glyceryl arachidate as equivalents of glyceryl stearate. In a preferred cosmetic composition, Mausner teaches used of glyceryl stearate in an amount of about 0.1 to about 2.0% (Col.4, lines 35-end; Col. 5, lines 1-50). Mausner teaches use of glyceryl stearate in an amount of 0.1-2.0% in a lotion (Table II, Columns 15 and 16).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl behenate (tribehenin) for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 because Alban teaches these reagents as equivalents. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that fatty acid esters such as glyceryl behenate (tribehenin) "and the like." (Col. 5, lines 55-end) may be used in the invention.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl behenate for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 of Alban because Alban teaches these reagents as equivalents that may be used in the invention.

With regard to the species of glyceryl palmitate and glyceryl arachidate, it therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute glyceryl palmitate and glyceryl arachidate for glyceryl stearate as the fatty acid ester gel forming agent of Example 1 because Mausner



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teaches both glyceryl palmitate and glyceryl arachidate as equivalents of glyceryl stearate. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that fatty acid esters other than glyceryl behenate and glyceryl stearate may be used in Alban's composition by teaching the fatty acid esters may be glyceryl behenate (tribehenin) "and the like."

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made substitute either glyceryl palmitate or glyceryl arachidate for glyceryl stearate because Mausner teaches glyceryl palmitate or glyceryl arachidate to be equivalents which may be used in cosmetic compositions.

With regard to the range of gelling agent (i.e. fatty acid ester used), Mausner teaches use of the fatty acid ester, glyceryl stearate, in an amount of 0.1-2.0% in a lotion (Table II, Columns 15 and 16), while Alban teaches use of the fatty acid esters in an amount of "about 0.5 to about 20%" (Col. 6 lines 10-25).

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing the composition taught by Alban by optimizing the amount of the fatty acid ester gelling agent in the composition within the prior art ranges (i.e. conditions) of 0.1 to about 20% because Mausner teaches that fatty acid gelling agents may be used as low 0.1-2.0% in lotion compositions and Alban teaches use of fatty acid ester in 0.5 to about 20%. The skilled artisan would have been motivated to do so because Alban invites routine optimization by teaching that the amount of fatty acid esters for use in the composition may be "about" 0.5% to "about" 20.0 %.

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It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amount of fatty acid ester gelling agents used in Example 1 of Alban to be between 0.1-20% by weight based upon the teachings of the prior art ranges for fatty acid gelling agents by Mausner and Alban.

With regard to the gelling agents being included in a concentration of 0.1-5% or 1.0-4.5%, The selection of 1-5% or 1.0-4.5% by weight gelling agent would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that fatty acid gelling agents may be used in topical oil in water emulsions in the form of a lotion compositions in an amount of 0.1-20% by weight based on the prior art teachings of Mausner and Alban. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not teach a range for the amount for optional components in the lotion composition.

Grollier teaches that sweet lupine seed powder may be present in an amount of 0.1 to 50% of a composition in which the vehicle may be a lotion (Claim 8). Grollier teaches that compositions made from Grollier's sweet lupine powder are unctuous and creamy (Col.2 lines 1-10). Compositions made from Grollier's sweet lupine powder are easy to apply to both the skin and the hair and the application is agreeable (Col.2 lines 1-10).

A person of ordinary skill in the art would have had a reasonable expectation of success in adding the powder, sweet lupine powder, taught by Grollier to the composition of Example 1 in an amount of 0.1 to 50% taught by Alban because Grollier

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teaches use of sweet lupine powder in this range to produce compositions which are unctuous. The skilled artisan would have been motivated to produce an unctuous composition that is easy to apply to the skin and Alban invites routine experimentation by teaching inclusion of optional components and teaching that these optional components may be in a "wide variety" of components (Col. 6, lines 35-45).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the sweet lupine powder taught by Grollier in an amount between 0.1-50% because Grollier teaches this amount of sweet lupine powder to produce unctuous compositions that are easy to apply to the skin.

Alban does not teach a range for the amount surfactant/emulsifier (Ceteareth-20) in the composition.

Robertson teaches that Ceteareth-20 is an emulsifier which may be present in amount between 0.1-10% by weight (Col. 8, lines 40-55) in suncare compositions delivered by topical carriers which are emulsions (Col. 2, lines 60-end), such as lotions (Col. 4 lines 45-65).

The selection of an amount of 0.1-10% by weight Ceteareth-20 would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Ceteareth-20 may be used in an amount of 0.1-10% by weight of emulsions which are topically applied to the skin, such as lotions as taught by Robertson. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not teach a range of water for the emulsion.

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The selection of Example 1 by Alban comprising 42-75%, 50-75%, and 56-75% water would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that Alban teaches that water may be added or subtracted as needed (i.e. "q.s.") based upon the reagents included in the composition. Alban teaches that the composition requires 8% water, the remaining amount may be varied as needed (Example 1, Col 11, lines 10-60). A holding of obviousness over the cited claims is therefore clearly required.

With the regard to the film forming agent, Alban teaches a silicone fluid comprising dimethicone and trimethylsiloxysilicate, however Alban does not teach an amount or specific range of film forming agent, trimethylsiloxysilicate, for use in the artificial tanning lotion which is an oil-in-water emulsion.

Ishiwatari teaches that trimethylsiloxysilicate is a silicone film forming agent (Col. 25, lines 55-60). Ishiwatari recommends use of trimethylsiloxysilicate in an amount of 0.01 to 50% in order to improve the effect of water resistance (Col. 24 lines 30-45) of oil in water emulsions (abstract).

The selection of 1-50 % by weight of the film forming agent, trimethylsiloxysilicate, would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that an amount of 0.01-50% trimethylsiloxysilicate may be used in oil in water emulsions, such as the artificial tanning lotion of Alban, as taught by Ishiwatari in order to improve the effect of water resistance. A holding of obviousness over the cited claims is therefore clearly required.

Alban does not teach “ad 100% by weight” of further carrier substances, auxiliaries, and active agents or mixtures thereof.

A person of ordinary skill in the art would have had a reasonable expectation of success in optimizing Example 1 of Alban through inclusion of optional components such as sunscreens, copolymers, humectants and emollients in an amount to ad 100% because Alban teaches these optional components may be included in the composition (Col. 6, lines 30-45). The skilled artisan would have been motivated to do so because Alban invites optimization of the composition by teaching that these reagents may be included. Furthermore, Alban invites optimization of ranges by stating that they reagents may be included in ranges that are “about” some specified range, providing further motivation to the skilled artisan. For example, the composition may comprise about 1% to about 30% by weight moisturizer or humectant (Col. 8 lines 10-20).

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the composition taught by Example 1 of Alban to include optional reagents in an amount of ad 100% because Alban teaches that these reagents may be optionally included in amounts which may be optimized.

With regard to instant claim 1, the phrase “a waterproof mascara composition” recites an intended use in the preamble of the composition. This preamble is not considered a limitation because the body sets forth the limitations of the claimed invention (i.e. the composition comprises a silicone base, water, oil, substances, gelling agent, film forming agents and etc). Please see M.P.E.P. § 2111.02-Preamble Statements Reciting Purpose or Intended Use. “If the body of a claim fully and

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intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alban, Coswar, Mausner, Grollier, Robinson, and Ishiwatari, and as evidenced by the Free Online Medical Dictionary reference for q.s. accessed 1/30/2009 from <http://medical-dictionary.thefreedictionary.com/q.s> and Edmundson, as applied to claims 1, 2, and 4-10 above, and further in view of US Publication No. 2002/0085984 (DiGirolamo, 2002).

The teachings of Alban, Coswar, Mausner, Grollier, Robinson, and Ishiwatari are relied upon as above. Furthermore, Alban teaches that the oil in water compositions of the invention comprise an oil phase which contains at least one fatty acid or fatty acid derivative (abstract).

However, Alban does not teach a composition comprising diisostearyl maleate as an ester in the oil phase.

DiGirolamo teaches a cosmetic composition comprising diisostearyl maleate (paragraph 12). DiGirolamo teaches that diisostearyl maleate is a "feel enhancing agent" (paragraph 12).

A person of ordinary skill in the art would have had a reasonable expectation of success in modifying the cosmetic composition taught by Alban by adding diisostearyl maleate as taught by DiGirolamo because DiGirolamo teaches that diisostearyl maleate may be added to cosmetic compositions. The skilled artisan would have been motivated to do so in order to modify the feel of the composition since DiGirolamo teaches that diisostearyl maleate is a "feel enhancing agent."

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Alban's composition by adding diisostearyl maleate because DiGirolamo teaches that diisostearyl maleate in cosmetic compositions enhances the feel of the composition.

Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2002/0081322 (Lawson, 2002) in view of US Patent No. 5451405 (Zhang, 1995), the product information sheet for Isostearyl Palmitate from JEECHEM accessed from <http://www.jeen.com/cartexe/pdfs/spec%20JEECHEM%20ISP.pdf> on

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1/28/2009, US Patent No. 6,391,835 (Gott, 2002), US Patent No. 5,013,763 (Tubesing, 1991) and US Patent No. 5,126,136 (Merat, 1992).

Lawson teaches a makeup gel formulation (paragraph 19). The composition is free of waxes and hydrocarbon solvents. The exemplified composition teaches a water phase; 5% mica; the film forming agent, polymethyl methacrylate; the silicone base, polymethylsilsesquioxane; and the nonionic surface active agent, PPG-20 methyl glucose ether in an amount of 4%. Also Lawson teaches that the behenic acid in the example undergoes a reaction *in situ* to form a sodium salt of a fatty acid ester gelling agent (paragraph 9 and 19). Lawson teaches additional auxiliaries such as preservatives like citric acid and other reagents such as sodium hyaluronate. Lawson teaches skin conditioning agents may be present in the composition (paragraph 16). Lawson also teaches the composition may comprise skin benefiting ingredients (paragraph 10).

Lawson does not exemplify the recited amounts of water, the recited amount of fatty acid ester gelling agent, or the amount of film former. Furthermore, Lawson does not teach use of a liquid ester or a cationic silicone polymer.

Lawson teaches that the gel comprises 10-60% water (paragraph 10). Lawson teaches that the *in situ* formed fatty acid ether gelling agent comprises from 1-5% of the composition (paragraph 7). The selection of specific amounts for water, and the gelling agent would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that the amount of gelling agent impacts the gel structure (paragraph 7), while the amount of water is dependent on the "remainder of



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the composition” (paragraph 10). A holding of obviousness over the cited claims is therefore clearly required.

With regard the amount of (poly)methyl methacrylate and polymethyl silsesquioxane as equivalents that enhance the look and feel of the skin (paragraph 15), these powders may used in an amount from 0.001-20% of the composition. The selection of specific amount of (poly)methyl methacrylate would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that the amount of (poly)methyl methacrylate impacts the look and feel of the skin. A holding of obviousness over the cited claims is therefore clearly required.

With regard to the composition comprising a liquid ester, Zhang teaches that isostearyl palmitate is an ester with emollient (i.e. skin conditioning) properties (Col. 6, lines 20-40).

Jeechem ISP teaches that isostearyl palmitate is a liquid.

A person of ordinary skill in the art would have had a reasonable expectation of success for improving the composition taught by Lawson by adding isostearyl palmitate (a liquid ester) to the composition because Lawson teaches that his composition may comprise skin benefiting ingredients and isostearyl palmitate is an emollient, according to Zhang. The skilled artisan would have been motivated to do so in order improve the moisturizing effect of the composition.

With regard to inclusion of cationic silicone polymers in the composition, Gott teaches that amodimethicone is a “cationized” silicone polymer (Col.6, lines 30-45).

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Tubesing teaches that amodimethicone is a substantive silicone for skin preparations which may comprise 0.1 to 8% by weight of the skin preparation (Col. 4 lines 10-25) which may be topical skin formulation such as a lotion (Col. 4 lines 40-50).

Merat teaches that amodimethicone is a non-slip binding agent which may be used in topical compositions such as lotions (Col. 4, lines 25-40).

A person of ordinary skill in the art would have had a reasonable expectation of success in improving the composition taught by Lawson by adding amodimethicone as a non-slip binding agent as taught by Merat. The skilled artisan would have been motivated to do so because Tubesing and Merat both teach use of amodimethicone for use in compositions applied to the skin such as lotions and Merat teaches amodimethicone's use as a binding agent for topical compositions.

It therefore would have been obvious to a person of ordinary skill in the art at the time the invention was made to add amodimethicone to the composition taught by Lawson because Merat teaches amodimethicone's use as a non-slip binder used in topical compositions.

With regard to the amount of amodimethicone to add to the composition, the selection of 0.8 to 2% use amodimethicone would have been a routine matter of optimization on the part of the artisan of ordinary skill, said artisan recognizing that use of amodimethicone in topical preparations applied to the skin may range from 0.1 to 8% by weight as taught by Tubesing. A holding of obviousness over the cited claims is therefore clearly required.

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Therefore, the invention as a whole would have been prima facie obvious to a person of ordinary skill at the time the invention was made.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M./

Examiner, Art Unit 1619

/Lora E Barnhart/

Primary Examiner, Art Unit 1651